

Appl. No. 10/059,502
Response to Office Action of May 20, 2005

Filed: January 29, 2002

REMARKS

Claims 1, 3, 5-8, 10-13, 18, 20-22, 28-30 and 34-44 remain pending in the present application. Reconsideration of the pending claims and allowance is respectfully requested in view of the following comments.

Claims 1, 3, 5-8, 10-13 and 34-44

Independent claim 1 and those dependent therefrom were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the combination of several references. Claims 1, 5, 11-13 and 34-44 were rejected as obvious of Tso *et al.* (U.S. Patent No. 6,047,327) in view of Tamura (U.S. Patent Publication No. 2002/0164004), further in view of Fratkina *et al.* (U.S. Patent Publication No. 2001/0049688). Claims 2-3 and 10 were found obvious in view of the combination of Tso *et al.* (U.S. Patent No. 6,047,327), Tamura *et al.* (U.S. Patent Publication No. 2002/0164004), Fratkina *et al.* (U.S. Patent Publication No. 2001/0049688) and Fascenda (U.S. Patent No. 6,560,604). Claim 4 was rejected as obvious in view of the combination of five references: Tso *et al.* (U.S. Patent No. 6,047,327), Tamura *et al.* (U.S. Patent Publication No. 2002/0164004), Fratkina *et al.* (U.S. Patent Publication No. 2001/0049688), Fascenda (U.S. Patent No. 6,560,604) and Indeken (U.S. Patent No. 5,694,120). Claims 6-8 were rejected as obvious of the combination of Tso *et al.* (U.S. Patent No. 6,047,327), Tamura *et al.* (U.S. Patent Publication No. 2002/0164004), Fratkina *et al.* (U.S. Patent Publication No. 2001/0049688) and Tijerina (U.S. Patent Publication No. 2002/0077120). These rejections are respectfully traversed.

Claim 1 has been amended to include the limitations of claims 2 and 4. Accordingly, claims 2 and 4 have been cancelled. The Office Action acknowledges that the primary reference, Tso *et al.*, fails to teach numerous features of amended claim 1:

- establishing a target list of internal business resources;

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- determining an arrangement of the component data and the components from the menu to form the preferential configuration, the arrangement including a menu of components denoting whether the component is required for supporting an internal business resource;
- forming the preferential configuration based upon the internal business resources to which the user has been provided access;
- limiting the capability of the user to write and delete data associated with one or more of the internal business resources based upon the user profile;
- presenting template data as the component data, the template data includes system architecture data and system integration data from previous configuration of the architecture for the wireless communication device; and
- presenting reference data as the component data, the reference data comprising a marketing tutorial and a financial data tutorial.

See Office Action mailed May 20, 2005 at 3-4, 12 and 14.

To reject amended claim 1, the Office Action would need to assert that the recited invention was obvious in view of the alleged, combined teachings of five references: Tso *et al.*, Tamura, Fratkina *et al.*, Fascenda and Indeken.¹ Applicants submit that such an assertion would be a classic example of impermissible hindsight where the Office Action is "picking and choosing" features from among numerous available features without any specific direction from the prior art to arrive at the claimed invention. *See In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). To establish obviousness based on a combination of elements disclosed in the prior art in multiple references, there must be some motivation, suggestion or teaching of the desirability of

¹ The Office Action required Tso *et al.*, Tamura, Fratkina *et al.*, Fascenda and Indeken to reject claim 4, which has been incorporated into independent claim 1.

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making the specific combination that is being claimed by the Applicants. Dissecting a claimed invention into individual elements or limitations and combining several prior art references allegedly disclosing each limitation to arrive at an obviousness determination amounts to a hindsight reconstruction of Applicants' claimed invention.

In rejecting claim 1, the Office Action merely provided a conclusory explanation that the references should be combined "in order to show alternative method of implementation." See Office Action mailed May 20, 2005 at 6. Applicants respectfully submit that absent the use of hindsight gleaned from the teachings of the present invention, there would be no motivation to arrive at the "alternative implementation." The notion of supporting an "internal business resource" is foreign to the system disclosed in Tso *et al.* Moreover, there is no motivation in Tso *et al.* to allow "limiting the capability of the user to write and delete data associated with one or more of the internal business resources based upon the user profile" because Tso *et al.* is a distribution system. In the system taught by Tso *et al.*, the information flows to the user from content providers.

If Tso *et al.* were modified as suggested by the Examiner to allow users to write/delete data on the content provider or InfoCast server, this would reduce the control that content providers have in the targeted distribution of data, which is a fundamental purpose of Tso *et al.*:

Another advantage of the system is that it allows information providers to target particular audiences for receiving information and advertisement. This ability to "focus" the dissemination of information allows information providers and marketers to only send information to users who might be interested in that information, reducing excessive waste of bandwidth and transmission capability. Specifically, the system allows the division of a general audience into different segments of targeted audiences at a fine level of granularity based on the criteria used.

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See Tso *et al.* at col. 1, lns. 55-65. If a user were to delete data from the content provider, for example, the content provider would be unable to distribute the data to other users in the same target audience. Moreover, if a user were able to alter data on an InfoCast server, the targeted audience for the data may also be altered. Thus, the altered data may be sent to uninterested users, thereby wasting bandwidth and transmission capability. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

For the reasons stated above, independent claim 1, and the claims dependent therefrom, are patentable over the prior art. Applicants respectfully urge that an indication of allowability for claims 1, 3, 5-8, 10-13 and 34-44 be provided.

Claims 18, 20-22 and 28-30

Independent claim 18 and those dependent therefrom were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the combination of several references. Claims 18, 21-22 and 26 were rejected as obvious of Tso *et al.* (U.S. Patent No. 6,047,327) in view of Tamura *et al.* (U.S. Patent Publication No. 2002/0164004), further in view of Dasan (U.S. Patent No. 5,761,622). Claim 20 was found obvious in view of the combination of Tso *et al.* (U.S. Patent No. 6,047,327), Tamura *et al.* (U.S. Patent Publication No. 2002/0164004), Dasan (U.S. Patent No. 5,761,622) and Fratkina (U.S. Patent Publication No. 2001/0049688). Claim 27 was rejected as obvious in view of the combination of four references: Tso *et al.* (U.S. Patent No. 6,047,327), Tamura *et al.* (U.S. Patent Publication No. 2002/0164004), Dasan (U.S. Patent No. 5,761,622) and Indeken (U.S. Patent No. 5,694,120). The Office Action rejected claims 28-30 as obvious in view of Tso *et al.* (U.S. Patent

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No. 6,047,327), Tamura (U.S. Patent Publication No. 2002/0164004), Dasan (U.S. Patent No. 5,761,622) and Tijerino (U.S. Patent Publication No. 2002/0077120). These rejections are respectfully traversed.

Independent claim 18 has been amended to include the limitations of claims 26 and 27. Accordingly, claims 26 and 27 have been cancelled. The Office Action acknowledges that the primary reference, Tso *et al.*, fails to teach numerous features of amended claim 18:

- a database for storing a candidate list of internal business resources;
- a database manager adapted to limit the capability of a user to write and delete component data associated with one or more internal business resources based upon the user profile;
- wherein the component data comprises reference data comprising a marketing tutorial and a financial data tutorial; and
- wherein the component data comprises a product list of suggested products that support at least one affiliated component..

See Office Action mailed May 20, 2005 at 18 and 21.

To reject amended claim 18, the Office Action would need to assert that the recited invention was obvious in view of the alleged, combined teachings of four references: Tso *et al.*, Tamura, Dasan, and Indeken.² Such a rejection of claim 18 would amount to improper hindsight. As discussed above, the Examiner is prohibited from "picking and choosing" features from

² The Office Action required Tso *et al.*, Tamura, Dasan and Indeken to reject claims 27, which have been incorporated into independent claim 18.

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among numerous available features without any specific direction from the prior art to arrive at the claimed invention. *See In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

The Office Action failed to recite any valid reason why these references should be combined. In fact, as with the rejection of claim 1, the Office Action merely provided a conclusory explanation that the references should be combined "in order to show alternative method of implementation." See Office Action mailed May 20, 2005 at 19. Applicant respectfully submits that this cursory explanation fails to satisfy the burden to establish a *prima facie* case of obviousness.

Moreover, modifying the system of Tso *et al.* as suggested by the Examiner would render the Tso *et al.*'s system unsatisfactory for its intended purpose. As discussed above with respect to claim 1, if Tso *et al.*'s system were modified to allow users to write/delete data, this would reduce the content providers' ability to control the targeted distribution of data, which is a fundamental purpose of Tso *et al.* See Tso *et al.* at col. 1, lns. 55-65. Since the modification to Tso *et al.* suggested by the Examiner would render the Tso *et al.*'s system unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

For the reasons stated above, independent claim 18, and the claims dependent therefrom, are patentable over the prior art. Applicants respectfully urge that an indication of allowability for claims 18, 20-22 and 28-30 be provided.

Conclusion

With this amendment and response, Applicant believes that the present pending claims of this application are allowable and respectfully requests the Examiner to issue a Notice of Allowance for this application. Should the Examiner deem a telephone conference to be beneficial in expediting

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allowance/examination of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

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